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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,268	02/16/2001	Jonathan W. Jarvik	2087-010262	5282
28289	7590	11/04/2005	EXAMINER	
THE WEBB LAW FIRM, P.C. 700 KOPPERS BUILDING 436 SEVENTH AVENUE PITTSBURGH, PA 15219			NEGIN, RUSSELL SCOTT	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/788,268		JARVIK, JONATHAN W.	
	Examiner		Art Unit	
	Russell S. Negin		1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 92-102 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 92 and 100-102 is/are rejected.
- 7) ☒ Claim(s) 93-99 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

NOTES

The previous communication regarding an *Ex parte Quayle* of March 29, 2005 has been rescinded in place of new grounds of rejection. The actions outlined in this report are, therefore deemed NON-FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 92 and 100-102 are rejected under 35 U.S.C. 102(a,e2) as being anticipated by Blanc et al. [USPAT 5,891,695].

It should be noted that this application was published as a WIPO document WO94/08014 on April 14, 1994 in French. A translation of this WIPO document is being requested at this time.

Claim 92 states as follows:

A method of analyzing a nucleotide, comprising:

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- a) providing a polynucleotide having homology to a defined DNA sequence;
- b) calculating the masses of two or more polypeptides encoded in two or more reading frames of said defined DNA sequence thereby obtaining a set of predicted mass values;
- c) expressing two or more polypeptides from two or more reading frames of said polynucleotide, thereby creating two or more expressed polypeptides;
- d) measuring the masses of said two or more expressed polypeptides, thereby obtaining a set of observed mass values; and
- e) comparing said set of predicted mass values to said set of observed mass values.

The preamble of the claim is stated in the abstract of '695 as "The invention concerns nucleotide sequences coding for a polypeptide."

Step a) in the method is anticipated in Example 1, column 9, lines 30-62 and Example 6, column 39, lines 45-51. Example 1 is entitled, "Isolation of total DNA of *Streptomyces pristinaespiralis* strain SP92." Example 6 contains the text, "it is possible to subclone DNA fragments containing these genes. These subclonings were performed in order to be able to deduce subsequently the nucleic acid sequence of the genes identified,..."

Step c) of the above method is anticipated in '695 Examples 5.1.1.B and 5.1.2 (columns 14 and 15). In example 5.1.1.B, *S. pristinaespiralis* SP92 Pristinamycin IIA

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Synthase is purified. The example claims that after this procedure, "the enzyme is pure and, in SDS-PAGE electrophoresis, two subunits of molecular weight estimated at 35,000 and 50,000 are detected." [column 15, lines 20-23] According to Example 5.1.2, polypeptide sequences to be examined, SnaA and SnaB, are cleaved from the protein via Edman degradation, and then purified using high performance liquid chromatography (HPLC). Thus, Example 5.1.2 not only anticipates step c) of the above method, but additionally anticipates claims 100 and 101, which claim "purification of the polypeptide" and "high performance liquid chromatography" as methods for accomplishing this task, respectively.

Steps b), d), and e) are anticipated in '695, column 46, lines 54-58, and 61-65, which state, "Frames 1 and 3 correspond respectively to the proteins SnaA (SEQ ID NO:17) and SnaB (SEQ ID NO:18) isolated above as described in Example 5 and for which the cloning of the genes is detailed in Example 6... ..Moreover, the molecular masses calculated from the sequences are comparable to the apparent molecular masses of the proteins SnaA and SnaB, estimates, respectively, in SDS-PAGE as described in Example 5." Thus, the polypeptide sequence has its molecular weight measured and calculated with both results being compared. Since '695 uses gel electrophoresis, Claim 102 is additionally anticipated (Claim 102 dictates methods of measurement of polypeptide masses).

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CLAIM OBJECTIONS

Claims 93-99 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

CONCLUSION

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the central PTO Fax Center. The faxing of such pages must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center Number is (571) 273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Negin, Ph.D., whose telephone number is (571) 272-1083. The examiner can normally be reached on Monday-Friday from 7am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Ardin Marschel, Ph.D., Supervisory Patent Examiner, can be reached at (571) 272-0718.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

Information regarding the status of the application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information on the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

R. Negin 10/30/05

Russell Negin 10/30/05

Ardin H. Marschel 10/30/05
ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER